

Att. Dkt. No. 025782-0111 (3648.Palm) (fka 035451-0135)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 25 is requested to be cancelled without prejudice.

Claims 1, 12, 24, 32 and 38 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-24 and 26-38 are now pending in this application.

Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claim 38 under 35 U.S.C. § 112 for lack of antecedent basis. As the Examiner suggested, claim 38 has been amended to depend from claim 37 in which case the limitation “the remote location” no longer lacks antecedent basis. Accordingly, Applicants respectfully submit a request that the rejection under 35 U.S.C. § 112 of claim 38 be withdrawn.

Claims Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1-5, 8-17, 20-25, 27-29, 31-34, and 37 under 35 U.S.C. § 102(b) as being anticipated by Costales et al. (U.S. Patent No. 6,044,395). The Examiner indicated that:

Costales teaches a method of sending common information to multiple destination sources using a handheld computer, the method comprising:

selecting information in a source file (col. 2, lines 50-53; wherein the common content chunk is selected from a source file and sent to the multiple-destination recipients);

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storing the selected information in memory (col. 2, lines 50-59; wherein the first portion of the e-mail is sent first and store in cache or memory waiting for the second portion to be reassembled);

selecting a remote destination (col. 2, lines 32-37; wherein every e-mail has a final destination);

adding destination-specific information to the selected information (col. 2, lines 54-57; wherein the destination-specific information is the second portion of the e-mail message containing information specific to the particular recipient); and sending the selected and destination-specific information to the remote destination (FIG. 3, ref. 304 & 306 and col. 2, lines 50-59; wherein the selected information is the common content chunks and the destination-specific information is the individual message to the recipient).

Costales teaches a method of sending personalized e-mail messages to recipients wherein each of the recipients receives messages which are personalized for them. To do this, Costales teaches that a common block of text is sent to the recipients and a personalized portion of the e-mail message is sent separately to the intended recipient and the first and second portions are then reassembled at the receiving computer.

With regard to independent claim 1, Applicants have claimed that the common chunk of information is not sent separately from the message. In fact, Applicants have amended independent claim 1 to recite "sending the selected and destination-specific information to the remote destination in a single message," the first among other limitations.

Prior to Applicants' claimed invention, what was done in the art was that a personalized e-mail message was created and sent to a recipient and then a second personalized e-mail message was created and sent and then a third personalized e-mail message was created and sent and so on. What Applicants have claimed is a method of sending common information to multiple destination sources and including destination-specific information. This is done by selecting some of the information in the message as common information which will be sent to all of the recipients and adding destination-specific information to the selected common

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information. The assembled message is then sent. The assembly and sending is repeated for a second set of destination-specific information, using the common information.

Costales et al. teaches away from assembling personalized e-messages at the originating computer. In fact, Costales et al. states, with respect to the prior art, "For each personalized e-mail to be sent, a system following the SMTP protocol pre-creates and individually sends each personalized e-mail message. Pre-creating such personalized messages prior to transmission requires large local disk storage and wastes network bandwidth during transmission." (col. 2, lines 18-25). Accordingly, Costales et al. teaches away from sending selected and destination-specific information in a single message, which Applicants have claimed.

Therefore, for all of the reasons above, Applicants respectfully submit that independent claim 1 is not anticipated by Costales et al. Further, claims 2-11 are not anticipated by Costales et al. in view of the amendment to claim 1 because claims 2-11 depend from claim 1. Therefore, Applicants respectfully submit that claims 1-11 are allowable.

With regard to independent claim 12, the Examiner indicated that:

Costales teaches a method of customizing information contained in an electronic file using a handheld computer based on the intended recipient of the information, the method comprising:

selecting information in a first electronic document (FIG. 3 and col. 2, lines 50-53; wherein the content chunk is the first electronic document and the whole information is selected and transmitted first);

automatically generating a second electronic document (col. 2, lines 54-57; wherein the second electronic document is the first and second portion that forms a complete e-mail message, and the complete e-mail is automatically generated by inserting the content chunk into the individual message), the second electronic document including the information selected from the first electronic document (col. 2, lines 57-59);

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choosing an output destination for the second electronic document (col. 2, lines 57-59; wherein each complete e-mail message has at least an output destination or recipient);

adding customized information to the second electronic document (col. 2, lines 54-59; wherein the individual message is customized information and it gets added to the common content chunk); and

delivering the second electronic document to the output destination (col. 2, lines 33-36; wherein the complete message is assembled and delivered to the final destination).

Applicants have amended independent claim 12 to recite "delivering the second electronic document to the output destination in a single message from the handheld computer" as well as "delivering the third electronic document to the output destination in a single message from the handheld computer." Accordingly, as Applicants stated with respect to independent claim 1, Costales et al. does not anticipate independent claim 12 because independent claim 12 claims automatically assembling destination-specific documents on the handheld computer and then delivering each of the destination-specific documents in a single message. Whereas what Costales et al. teaches is sending a first portion of a message which is a common portion to multiple recipients and then sending a personalized portion over a communication network to specific recipients and then assembling the personalized message at the receiving computer. Accordingly, Applicants respectfully submit that independent claim 12, as amended, is not anticipated by Costales et al. and is therefore allowable. Further, claims 13-23 which depend from claim 12 are also allowable.

With regard to independent claim 24, the Examiner indicated that:

Costales a method (sic.) of conveying electronic information to members of a defined group using a handheld computer, the method comprising:

creating a distribution group including a plurality of recipients (col. 2, lines 33-36; wherein the multiple e-mail messages are in a distribution group);

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generating a first electronic file, the file including common information to be sent to at least one of the plurality of recipients (col. 2, lines 50-53 and FIG. 3, ref. 304);

choosing a first recipient from the plurality of recipients in response to a user prompt (FIG. 5A, ref. 505; wherein after the "TO:" prompt the user chooses a first recipient by entering the first email address);

entering a first customized set of information in the electronic file tailored to the first recipient (col. 2, lines 54-57; wherein the second portion of the e-mail contains information specific to the first recipient); and

sending the common information and the first customized set of information to the first recipient (col. 2, lines 36-37).

Independent claim 24 has been amended to recite "sending the common information and first customized set of information to the first recipient within a single message" and "sending the common information and the second customized set of information to the second recipient within a single message." among other limitations. Again, as discussed earlier with regard to claim 1, Costales et al. does not disclose or teach sending both common information and customized destination-specific information in single messages to the receiving computer. Accordingly, Applicants respectfully submit that independent claim 24, as amended, is not anticipated by Costales et al. and is therefore allowable. Further, claims 26-31 which depend from claim 24 are also allowable.

With regard to independent claim 32 the Examiner indicated that:

Costales teaches a handheld computer, comprising:

a processor (FIG. 2, ref. 202 and col. 3, lines 46-49);

a display coupled to the processor (FIG. 2, ref. 216 and col. 3, lines 46-49);

a memory coupled to the processor (col. 3, lines 46-49); and

a program running on the processor,

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the program configured to enable a user to create an electronic template document having a first set of information (col. 2, lines 50-54; wherein the e-mail message template contains the first portion of the message or the first set of information),

the program configured to automatically transfer the first set of information into at least one destination-specific document (col. 2, lines 54-59; wherein the selection of the common content chunks is performed automatically by the e-mail system to insert into the individual message specific to the recipient),

the program enabling the entry of destination-specific information into the at least one destination-specific document (col. 2, lines 54-59).

Independent claim 32 has been amended to recite "the program configured to send the destination-specific document in a single message to a receiving computer." As discussed above with regard to independent claim 1, Costales et al. does not disclose or teach that the originating computer sends a destination-specific document in a single message to a receiving computer.

What is sent by Costales et al. is separate messages in which common information is first transmitted and then customized information is transmitted and the document or messages assembled at the receiving computer. Accordingly, Applicants respectfully submit that Costales et al. does not anticipate independent claim 32, as amended, and is therefore allowable. Further, Applicants respectfully submit that claims 33-38 which depend from claim 32 are also allowable.

Claim Rejections – 35 U.S.C. § 103

With regard to claims 6, 7, 18, 19, 30, 35 and 36 which the Examiner indicated as being rejected under 35 U.S.C. § 103(a) as being unpatentable over Costales in view of Beck et al. (U.S. Patent No. 5,903,723). Beck et al. does not provide a suggestion for the deficiencies of Costales. Beck et al. only discloses the use of an attachment reference in an e-mail message. The teachings of Beck et al. thus have no logical connection to filling in the deficiencies of Costales. Further, Applicants respectfully submit that in view of the amendments made to independent claims 1, 12, 24, and 32, claims 6, 7, 18, 19, 30, 35, and 36 which depend from the

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amended independent claims are also allowable and may not be rendered obvious over Costales in view of Beck et al.

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Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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